Supreme Court of the United States.

OCTOBER TERM, 1903.

No. 383.

UNITED STATES EX RELATIONE CHARLES P. STEINMETZ, PLAINTIFF IN ERROR AND PETITIONER,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

Petition for Writ of Certiorari to the Court of Appeals of the District of Columbia.

Comes now Charles P. Steinmetz, plaintiff in error and petitioner, and prays a writ of certiorari to the Court of Appeals of the District of Columbia in the above-entitled cause, and in support thereof says:

This is a proceeding by mandamus commenced in the Supreme Court of the District of Columbia by the United States on the relation of Charles P. Steinmetz, to compel Frederick I. Allen, Commissioner of Patents, to allow an appeal to the Board of Examiners-in-Chief from a decision of the Primary Examiner refusing and rejecting, a second time, the relator's application for patent because relator would not cancel from it certain claims, as required by the

Primary Examiner under the alleged authority of certain rules of Patent Office practice and decisions thereunder.

The Supreme Court of the District of Columbia refused the writ, and its judgment was affirmed, on appeal, by the Court of Appeals of the District of Columbia. A writ of error was sued out from this court to review the judgment of the Court of Appeals of the District of Columbia.

The case made by the relator's petition for mandamus is substantially as follows:

THE PETITION.

On the 21st day of November, 1896, the relator filed in the Patent Office an application for patent for his invention of new and useful Improvements in Motor Meters. This application contained and still contains thirteen (13) claims, covering the different phases of the invention; claims 1 to 6, inclusive, being, in terms, directed to the novel method or process involved in the working of the invention, and claims 7 to 13, inclusive, being, in terms, directed to the novel means or apparatus by which such method is carried into practice.

On the 15th day of May, 1900, the Primary Examiner—to whom, according to law, the application was referred by the Commissioner of Patents—examined and considered the application and decided that claims 17 to 13, inclusive, to the apparatus part of the invention, must be canceled. A reconsideration of this action was requested, and was granted, and the Primary Examiner, on the 31st day of July, 1900, repeated the requirement.

Regarding this last action as an adverse decision and as a

second rejection and refusal of his claims 7 to 13, inclusive, the relator appealed to the Board of Examiners-in-Chief, with a view to having the validity of the action of the Primary Examiner revised and determined by that tribunal, according to law.

The Primary Examiner, on the 9th day of August, 1900, refused to forward the appeal, with his answer thereto, on the ground that the question involved in the appeal was not one of which the Board of Examiners-in-Chief had jurisdiction, and therefore not appealable to that tribunal. A reconsideration of this action of the Primary Examiner was requested, and granted, and the action was, on the 16th day of August, 1900, repeated.

On the 20th day of August, 1900, the relator petitioned the then Commissioner of Patents to direct the Primary Examiner to answer and forward relator's appeal, which petition was on the 28th day of December, 1900, denied.

On the 16th day of January, 1902, a like petition was presented to the present Commissioner of Patents, the respondent herein, and on the 7th day of February, 1902, said petition was likewise denied.

On the 28th day of February, 1902, the relator directly petitioned the Board of Examiners-in-Chief to take jurisdiction of his appeal, but this petition was, on the 6th day of March, 1902, also denied, on the ground that the Examiners-in-Chief could not, under the Rules of the Patent Office, revise and determine the validity of the Primary Examiner's action without the latter's answer to the appeal, and, further, because of the previous action of the Commissioner in the premises.

The prayer of the relator's petition is that the respondent

be commanded to direct the Primary Examiner to answer and forward the relator's appeal to the Board of Examiners-in-Chief in order that the relator may have the benefit of a review of the Primary Examiner's action by the last-named tribunal and of the other appellate tribunals, if necessary.

THE RETURN.

The respondent's return admits that the relator is the true, original and first inventor of the invention for which he solicits a patent; admits that the relator's application contained and contains the claims set out in the petition, and that the relator's claims 7 to 13, inclusive, to the apparatus part of the relator's invention, were twice required to be cancelled by the Primary Examiner. It admits, further, the filing of the appeal by the relator from the decision of the Primary Examiner to the Board of Examiners-in-Chief and the taking of the various steps by the relator, as set out in the petition, in his endeavor to perfect his said appeal and to have the same determined by the Examiners-in-Chief.

It denies that any of the claims of relator's application has been twice, or at all, rejected; denies that any right of appeal to the Board of Examiners-in-Chief has accrued to relator, and attempts to justify the action of the Primary Examiner and of the respondent, on the ground that the ruling of the Primary Examiner was merely a requirement of division of relator's application under Rule 41 of Patent Office practice, which rule the Commissioner, with the approval of the Secretary of the Interior, had authority to make, and did not involve the rejection of any claim, or an action upon the merits of relator's application, such as would

entitle the relator to an appeal under the statute, or under Rule 133 of Patent Office practice.

In the Commissioner's decision, made part of the return (Exhibit B), it is admitted that all the claims of relator's application are allowable, but it is asserted that the refusal of the Office to grant a single patent embracing all of the claims is merely "a question of procedure or of the manner of securing protection" and "not of the right of the applicant to a patent upon any of the claims presented."

The return further sets forth that the relator is estopped by his conduct to question the validity of the Primary Examiner's requirement of division; and denies, generally, the denial of any right to the relator and of the relator's right to the relief prayed.

The relator moved for judgment, notwithstanding the return.

Mr. Justice Barnard, who heard the case in the Supreme Court of the District of Columbia, ruled that the decision of the Primary Examiner appealed from was only interlocutory in character; did not amount to a refusal or rejection of relator's application for a patent; and was not appealable under the statute or under the rules, to the Board of Examiners-in-Chief, and he denied the writ and dismissed the petition.

This judgment was affirmed by the Court of Appeals of the District of Columbia, that court holding that the requirement of division was a matter resting in the discretion of the Commissioner; that his judgment on that question was final; and that his rule made pursuant to his statutory authority to make rules, cutting off the appeal to the Board

of Examiners-in-Chief from the judgment of the Primary Examiner, was valid and not inconsistent with the statute regulating appeals.

The case made on the proceedings in error is now docketed in this court as No. 383 of October Term, 1903, and on motion of the Solicitor General has been advanced to be heard immediately after the case of *Ex parte* Frasch, Original No. 13, October Term, 1903.

It appears that the jurisdiction of this court in your petitioner's case No. 383, brought here on proceedings in error, is dependent wholly upon whether there is "drawn in question the validity" "of an authority exercised under the United States."

The underlying question most seriously affecting the right of your petitioner and of thousands of other inventors, namely, the authority of the Commissioner of Patents to make and enforce rules and regulations defining and limiting the right of appeal conferred by sections 482 and 4909, Revised Statutes, and to arbitrarily require division of an application for patent containing claims for a process and for an apparatus for carrying such process into effect, against the wishes and at the expense of the applicant, is one of great gravity and importance and is evidently so considered by the Government, as evidenced by its motion to advance No. 383, and inasmuch as the judgment of this court upon such question might not be obtained should the objection to its jurisdiction in case 383 be sustained, your petitioner prays—

1. That a writ of certiorari issue to the Court of Appeals of the District of Columbia.

2. That the record of said suit, already in this court in case No. 383, be received and accepted as the record in such certiorari proceedings.

3. That the hearing of said case No. 383 and of the case made under the certiorari proceedings be made concurrent.

4. That the briefs and arguments filed and to be filed in said case No. 383 be received and applied to the case made under the certiorari proceedings.

5. That such other and further relief be granted as the nature of the case shall seem to demand and as to this court shall seem proper.

CHARLES P. STEINMETZ.

FREDERICK H. BETTS,
MELVILLE CHURCH,
Of Counsel for Plaintiff in Error and Petitioner.

DECEMBER 16, 1903.

DISTRICT OF COLUMBIA, *ss:*

Charles P. Steinmetz, being duly sworn, deposes and says, that he is the complainant in the foregoing petition named, that he has read the said petition and knows the contents thereof, that the same is true of his own knowledge, except as to those matters which are therein stated to be on information and belief, and as to those he believes it to be true.

CHARLES P. STEINMETZ.

Sworn to and subscribed before me this 16th day of December, 1903.

THOMAS DURANT,
Notary Public.